



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,820	12/14/2000	Hao A. Chen	3620-036-01	8675

7590 08/01/2002

Luke A. Kilyk, Esq.
KILYK & BOWERSOX, P.L.L.C.
3603-E Chain Bridge Road
Fairfax, VA 22030

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/736,820		CHEN ET AL.	
	Examiner		Art Unit	
	Jane J Rhee		1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 19, 20, 22, 23 and 27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 19, 20, 22, 23 and 27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

REJECTIONS REPEATED

1. The 35 U.S.C. 112 rejection of claims 23, 1 and 19 is repeated for the reasons previously of record in Paper #4, Page 3, Paragraph 1.
2. The 35 U.S.C. 102 rejection of claims 1-6 as anticipated by Peralt Anstalt is repeated for the reasons previously of record in Paper #4, Page 3, Paragraph 2.
3. The 35 U.S.C. 103 rejection of claims 19-20 over Peralt Anstalt in view of Del Rincon et al. is repeated for the reasons previously of record in Paper#4, Page 4, Paragraph 3.
4. The 35 U.S.C. 103 rejection of claims 22,23,27 over Peralt Anstalt in view of Boultinghouse is repeated for the reasons previously of record in Paper#4, Page 5, Paragraph 4.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 31 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Peralt Anstalt in view Brown (5205091).

Peralt Anstalt discloses a surface covering comprising two or more polymeric planks having edges wherein the bonding agent is present on at least one of the edges

of at least one of the planks, and wherein the bonding agent comprises at least one solvent capable of at least bonding the edges of the planks (col. 2 lines 78-86). Peralt Anstalt fail to disclose that the surface covering comprises a floor. Brown teaches a floor surface covering comprising two or more polymeric planks having edges wherein the bonding agent is present on at least one of the edges of at least one of the planks, and wherein the bonding agent comprises at least one solvent capable of at least bonding the edges of the planks (col. 9 lines 67-98 and col. 10 lines 1-22) for the purpose of obtaining a resilient dynamic system of flexible joints utilized to join the tiles together (col. 7 lines 47-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a floor surface covering comprising two or more polymeric planks having edges wherein the bonding agent is present on at least one of the edges of at least one of the planks, and wherein the bonding agent comprises at least one solvent capable of at least bonding the edges of the planks in order to obtain a resilient dynamic system of flexible joints utilized to join the tiles together (col. 7 lines 47-48) as taught by Brown.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments filed in paper #5 regarding the 35 U.S.C. 112 rejection of record have been fully considered but they are not persuasive.

The term "capable" is rendered indefinite failing to distinctly define the present invention. However, the deletion of the term would further clarify the claimed invention. For example, "...wherein said bonding agent comprises at least one solvent bonding at least one of the edges of the planks." The term "capable" is rendered indefinite because it can be interpreted as a possibility of bonding the edges of the planks with the solvent wherein there is no definiteness of the bonding of the edges of the planks with the solvent stating that it may or may not bond together.

The term "laminate" is rendered indefinite failing to distinctly define the present invention. A laminate has a broad definition of uniting several layers together.

7. Applicant's arguments filed in Paper #5 regarding the 35 U.S.C. 102 rejections of claims 1-6 anticipated by Peralt Anstalt have been fully considered but they are not persuasive.

In response to the applicant's argument that Peralt Anstalt shows a different product that is joined together in a completely different manner, Peralt Anstalt does disclose an edge-to-edge bond regardless if it overlaps. Peralt Anstalt discloses two or more polymeric planks having edges (col. 1 line 17) wherein the planks are connected to each other by a bonding agent (col. 1 lines 17-18), wherein the bonding agent is present on at least one of the edges of at least one of the planks (col. 1 line 18), and wherein the bonding agent comprises at least one solvent capable of bonding the edges of the planks (col. 1 lines 19-22). Also, Peralt Anstalt does disclose a direct edge to edge bond wherein the edge of one surface is adjacent to the an edge of the other

surface with a welding solvent applying means for applying the welding solvent along the entire length of the edges (col. 2 lines 75-84).

As to the argument wherein the large number of potential welding agents listed in the previous action were not located in Peralt Anstalt, the applicant claimed that the bonding agent *comprises* tetrahydrofuran, cyclohexanone, methylene chloride, dimethyl formamide, toluene, acetone, ethylene dichloride, methyl ethyl ketone, n-methyl pyrrolidone, methyl isobutyl ketone, dipropyl ketone, isophorone, methyl amyl ketone, nitrobenzene, methyl cyclohexanone, acetonyl acetone, or combination thereof meaning that only one compound was necessary to meet the applicant's claimed bonding agent and furthermore, the examiner listed all the alternatives of the bonding agent to illustrate that one of the bonding agent compound is used and that all the limitations of the claims were clearly met.

As to the argument that the term "two opposite edges" does not appear in the passage cited by the examiner and that on the contrary, the identified passage specifically refers to "overlapping edges", the term "two opposite edges" was broadly interpreted as two opposite edges meeting together regardless of overlapping. Overlapping edges are two opposite edges uniting together which therefore met the claims limitation on "two opposite edges".

8. Applicant's arguments filed in Paper #5 regarding the 35 U.S.C. 103 rejections of claims 19-20 over Peralt Anstalt in view of Del Rincon et al. have been fully considered but they are not persuasive.

In response to Applicant's argument that Del Rincon et al. does not relate to the same sort of material as the claimed invention, therefore making it impossible for organic solvents such as THF that would clearly bond polymeric materials together could be used to achieve similar results with wooden planks because wooden planks is simply not soluble in organic solvents, Del Rincon et al. teaches a polymeric spline (col. 2 lines 5-11) which therefore can be combined with Peralt Anstalt's polymeric planks for the purpose of joining the planks together (col. 1 line 5) and eliminate the use of THF on wooden planks.

In response to Applicant's argument that it is physically impossible to combine the teachings of the two references because Peralt Anstalt concerns overlapping panels and that one cannot place a spline between two panels that are not joined edge to edge, Peralt Anstalt discloses that the sheets are joined together wherein the edge of one surface is adjacent to an edge of the other surface (col. 2 lines 78-85) therefore, it is physically possible to combine the teachings of the two references.

9. Applicant's arguments filed in Paper#5 regarding the 35 U.S.C. 103 rejections of claims 22, 23 and 27 over Peralt Anstalt in view of Boultinghouse have been fully considered but they are not persuasive.

In response to Applicant's argument that Peralt Anstalt does not refer to a polymeric core with a laminate affixed to the surface of the core and that the cite merely refers to sheets of "plastic material", Peralt Anstalt discloses that the sheets are made of plastic material which also can be referred to as polymeric material (col. 1 line 12) and

that the polymeric plank is made of two sheets combined into a two film laminate (col. 6 line 74) wherein one of the laminate can be defined as the polymeric core and the other laminate fixed to the surface of the core.

In response to Applicant's argument that Boultinghouse does not show the presence of "at least two different solvents", Boultinghouse does disclose a welding composition containing "at least one hydroxyl-ether and /or keto-ether" (col. 1 line 47) and in addition a viscosity improving amount of a polymer such as any polymer so long as it is compatible with polymer material to be welded (col. 3 lines 16-29). Therefore, Boultinghouse not only infer from the phrase "at least one" that more than one solvent can be used but also supplies an additional solvent to the welding composition.

As to the argument, wherein the welding composition of Boultinghouse cannot be combined with the welding solvent of Peralt Anstalt, it was not intended to combine the welding composition of Boultinghouse and the welding solvent of Peralt Anstalt together but to replace Peralt Anstalt's welding solvent with Boultinghouse's welding composition in order to provide a permanently welded resinous block copolymer (col. 1 line 34).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1772

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-301-9999 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
July 26, 2002



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

7/27/02